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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,077	10/06/2000	Paul Bilbin	PSTM0020/MRK/STM	3148
29524	7590	05/20/2005	EXAMINER	
KHORSANDI PATENT LAW GROUP, A.L.C. 140 S. LAKE., SUITE 312 PASADENA, CA 91101-4710			WEBB, JAMISUE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/685,077

Applicant(s)

BILIBIN ET AL.

Examiner

Jamisia A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20050302.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the RCE with corresponding amendment filed March 2, 2005.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8-13, 15-20, 22-27, 29-34, 36-41, and 43-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Nicholls et al. (5,485,369).

4. With respect to Claims 1-5, 8-12, 15-19, 22-26, 29-33, 36-40, and 43-57: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to (column 4, lines 8-24, and columns 15-27) collect parcel specifications, such as weight and dimensions (Figures 4A and 4B), and determines a dimensional weight (Columns 21 and 22, line 65) and uses the weight to calculate rates for the shipment (column 5, lines 34-40, columns 25 and 26, line 39). The examiner considers this to be a dimensional weight calculation rule. Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of the parcels according to the rules

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(See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45) by a shipper, where the shipper has a unique ID (See Columns 17 and 18, Table II-continued).

5. With respect to Claims 6, 13, 20, 27, 34, and 41: See Column 8, lines 43-55.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 7, 14, 21, 28, 35 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al. in view of Kara et al. (6,233,568).

9. Nicholls, as disclosed above for claims 3, 10, 17, 24, 31 and 38, discloses the use of calculating rates for multiple carriers, but discloses the automatic selection of the carrier, and fails to disclose displaying all of the rates to the user. Kara discloses a computer program used

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for multiple shippers that displays that calculate shipping rates of multiple carriers for multiple services (See Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. See Kara, column 22

### *Response to Arguments*

10. Applicant's arguments filed 3/2/05 have been fully considered but they are not persuasive.

11. With respect to the Claim interpretation of "billable weight" "dimensional weight" and "ratable weight": It is the examiner's position that given the definition and the claims as well as the definition in the specification, that these three weights can be the same. The dimensional weights is a weight that is calculated according to the actual weight of the parcel, with physical dimensions calculated in. This is a common weight calculation that is done by carriers, to compensate for over sized items. Applicant defines a billable weight to say that it can be a selection according to a group of different weights, in that group, is the dimensional weight. Therefore the billable weight can equal the dimensional weight. The applicant has defined the ratable weight as being based on the billable weight and the dimensional weight. Therefore, due to the fact that the billable weight and the dimensional rate can be the same, then the ratable weight can equal the billable weight which can equal the dimensional weight. So as long as a reference uses the dimensional weight, for billing and rating, then the reference would anticipate

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this limitation in the claims. Nicholls using the dimensional weight for the billing and rating, therefore Nicholls anticipates this limitation, and the rejections stand as stated above.

12. With respect to applicant's arguments corresponding to the phrase "each user has a user-specific origin identifier": It should be noted that the applicant has added this into the claim, but has merely stated that each user has one. The claims never state how this identifier is used, and what it is used for. The applicant states that the system of Nicholls is such that distinct versions of the Nicholls system are installed for the distinct user. Nicholls discloses a system with multiple servers, each running different processes, but overall is still one system, in which the user (shipper) accesses. The user interact of the shipper may be customized, but the system of Nicholls receives the input, and the different processes of the Nicholls does the calculations and rates the shipping. The user device of Nicholls does not do this. The same way as if MSN, AOL, and yahoo can customize the way a user views the web page, but the programming and all the tasks, are actually done on the server, not on the user's computer. The applicant's states that Nicholls discloses that distinct version is installed for each user, but the applicant only points to where Nicholls states that "the system is pre-programmed with a set of rules which are reflective of a shipper's predefined set of shipping requirements". This statement does not state that a distinct version is installed on each user's computer. The examiner asks that the applicant point out where Nicholls discloses that it is installed on each user's computer, and where, if at all that Nicholls states that the calculations with respect to weight and rates, are done on the individual computers, not the servers (which would be the system). The examiner considers Nicholls to teach all the steps being performed on the system servers or processes, therefore the rejection stands as stated above.

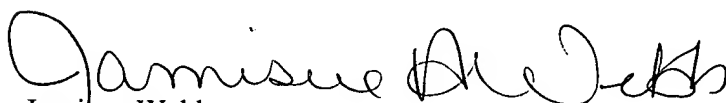
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13. With respect to applicant's arguments that Kara does not disclose a display for multiple carriers and multiple services. The claims merely state a display for comparison. The claims does not states that they must be simultaneously displayed, or disclose that they are displayed in any specific manner. The examiner considers Kara to disclose the display of rate for different carriers for different services for comparison, therefore rejections stand as stated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jamisue Webb

  
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